

EXHIBIT A

ARGUMENT RE CLAIMS SUBJECT TO 37 C.F.R. 1.131

Reference is made to the present application at page 12, lines 4-11. Applicant here explains that whereas he concedes that the feed tube is important to the invention, the conduit support mounted to the machine as distinguished from the feed tube is optional.

"In all cases where flexible conduit is utilized, it is believed that a securely positioned rigid feed tube is important to avoid displacement due to material turmoil caused by the filling process. Whereas a rolled flexible tube is believed most convenient, it is also contemplated that rigid conduit sections may be utilized with the successive sections being coupled one to the other as they are fed through a straight tube and into the bag." (Emphasis added)

The conduit support (reel) for the conduit to enable the conduit to be mounted to the bag filling machine was specifically excluded from the broad claims of the application. It is to be noted that this conduit support is a different limitation than the feed tube, i.e., it is the support that supports the entire length of conduit to be placed in, e.g. a 300 foot bag length. The limitations including the conduit support being mounted on the bag filling machine were included only in Claims 7 and 8. During prosecution, Claims 7 and 8 were allowed and all other claims not including the conduit support were rejected.

At substantially the same period of time, the parent case to Cullen's U.S. Patent No. 5,426,910, namely U.S. Patent No. 5,345,744 was being prosecuted. Cullen pursued claims with and without the conduit support (referred to by Cullen as a pipe support). The Cullen claims were rejected. Cullen ultimately dropped the claims that did not include the conduit support and pursued the claims requiring the conduit support. After a number of amendments directed to the conduit (pipe) support, the Cullen claim in the '744 patent was granted.

Just prior to the grant of the '744 patent, Cullen filed a continuation application, again

pursuing claims with and without the conduit (pipe) support. Again the claims were rejected and the '910 patent was ultimately granted with claims limited to the conduit support. The claims of the two cases were considered the same invention for double patenting purposes and a terminal disclaimer was filed to overcome the double patenting rejection.

Summary of '910 Prosecution History

Cullen initially did not claim a pipe support, but did claim positioning means. After rejection based on Eggenmuller, Cullen added the pipe support.

The examiner rejected the amended claim, including both the positioning means and pipe support, again based on Eggenmuller, asserting that the stand 8, having a hole through which a vent tube was inserted, functioned both as a pipe support and as a positioning means. (See Fig. 10 of Eggenmuller, 3687061 attached.)

"The pipe's positioning means is read as the end of the bag and the stand 8 in Eggenmuller. The pipe support is read as the hole in the stand 8 of Eggenmuller. Therefore, the pipe support supports the pipe as the pipe is positioned on the stand and in the bag."
(Page 4 of Paper 5).

Cullen responded by amending the claims to recite that the positioning means positions the pipe and the pipe support supports the pipe prior to the positioning means positioning the pipe. He then argued that Eggenmuller does not disclose "the positioning means for positioning an elongated perforated pipe - as well as the pipe support on a wheel frame means for supporting the perforated pipe thereon prior to the perforated pipe being positioned in the compost material." (From Paper 6 of the file wrapper.)

The above prosecution history of the Cullen patent is of importance in that it is the process that determined what was patentable to Cullen, a process he participated in and concurred with. From that process, the patentable invention of Cullen specifically requires, in combination, a

"pipe support" and separately a "positioning means." The pipe support cannot be considered immaterial to the Cullen claims. No machine or process not including a pipe support mounted on the machine can be considered an infringement of the Cullen claims, either as a direct infringement or under the Doctrine of Equivalents (in view of file wrapper estoppel).

In order to establish an interference with the Cullen patents, one would have to include the pipe support limitation. An argument that the pipe support limitation is an immaterial limitation of Cullen for the purposes of declaring an interference with the issued Cullen patent would necessarily fail. Such a claim (the claim minus the pipe support limitation) is not allowable to Cullen and cannot be the basis for interference with the Cullen patent.

From MPEP 2306, Interference Between an Application and a Patent, page 2300-15:

"Since the claims of a patent may not be altered (except by reissue or reexamination), the applicant must claim the same patentable invention as is claimed in one or more claims of a patent in order to provoke an interference with the patent. The fact that the patent may disclose subject matter claimed by the applicant is not a basis for interference if the patent does not claim that subject matter."

Whereas applicant concurs that the claims of an application and the claim of a patent do not have to be exactly the same, it is required that the claim of the application claim the "same patentable invention as a claim of the patent." From MPEP 2306:

"All that is required under present practice is that a claim of the application be drawn to the same patentable invention as a claim of the patent."

The examiner in the present case initially took a position consistent with that of the examiner in the Cullen cases. The examiner in the present case allowed those claims which included the conduit support and rejected the claims without the conduit support. Applicant in this case (unlike Cullen) is persisting in the allowability of the claims without the conduit support

limitation. Applicant has assertedly removed Cullen as a prior art reference by the submission of an affidavit under Rule 131. Applicant's invention predates the filing date of Cullen and Cullen does not claim the same invention, i.e., the Cullen claims must be considered as a whole and the Cullen claims require a material element/step not included in applicant's claims. The claims in issue do not qualify for interference with the Cullen claims and *ipso facto* a Rule 131 affidavit is appropriate for removing Cullen as a reference.

From "Chishum on Patents" at 3-139 to 140.10:

"In 1988, in response to the Eickmayer decision, the Patent and Trademark Office amended Rule 131 to provide that the standard of identity of invention which precludes use of a Rule 131 affidavit or declaration to avoid a prior art reference, is the same as that used for determining interference."

The examiner in the present case refutes applicant's contention and is holding that the pipe support limitation is an immaterial limitation and accordingly it is his position that the Cullen patent(s) claim the same patentable invention as claimed by the claim here in issue. Accordingly, he has rejected applicant's 131 affidavit and this is error.

Applicant's claims do not include the pipe support limitation and cannot qualify for declaration of interference with the claims of the Cullen patents. It follows under the Patent and Trademark Office's own rules that if the claims do not qualify as the same invention for interference purposes, they do qualify under Rule 131 as claiming different inventions.

Also note the similarity of applicant's situation to that of In Re Braat, 19 USPQ 1289 at page 1292 (CAFC 1991). The Braat broader application claims were under rejection for double patenting based on the narrower claims of an issued patent to Dil (commonly owned). (Whereas the Braat case involves double patenting, note from MPEP 2306 under Interference Between an Application and a Patent, at page 2300-15: "The test is analogous to that applied

for double patenting." From the Braat case:

"The crux of this appeal comes down to whether the Board erred in applying a 'one-way' patentability determination instead of a 'two-way' determination. The Board correctly found that the rejected claims of Braat are merely obvious variations of the invention described by dependent Claims 5/1 and 6/1 of Dil. The only difference between the claims of Braat and Claims 5/1 and 6/1 of Dil is the *omission* of the requirement in the claims of Dil of information areas having side walls which are angled at a particular angle, and we do not think that *omission* of such a limitation in the present case would constitute an unobvious modification. The issue is whether the Board erred in concluding that such a one-way determination was all that was necessary or whether it was necessary to also determine whether the claims of Dil are patentably distinct from the invention described by the rejected claims of Braat; i.e., whether the *addition* in the claims of Dil of side walls which are angled at a particular angle was merely an obvious modification over the invention claimed in Braat."

Following analysis, the court in the Braat case determined (at page 1293):

"Thus a double patenting rejection is sustainable here only if Claims 5/1 and 6/1 of Dil are not patentably distinct from the subject matter defined by the rejected claims of Braat and the Board erred in sustaining the double patenting rejection without making such a two-way determination."

The issue of allowability when considering the addition of the conduit/pipe support has been decided. The present examiner allowed Claims 7 and 8 adding the conduit support to the herein rejected parent Claim 6. The same decision was made in the Cullen application where not once but twice the examiner there allowed the claims with the conduit/pipe support over the rejected parent claims. Only when the decision is made from the opposite direction is the claim not considered allowable based on double patenting, i.e., the claims here in issue not including the pipe/conduit support are considered not allowable because now the pipe/conduit support is considered an immaterial limitation.

Based on the examiner's own two-way test and in accordance with the holding of In Re

Braat, the determination by this examiner that the limitation of the conduit/pipe support is an immaterial limitation for refusing applicant's 131 affidavit is error.

The items of the present invention referred to as "conduit" and "feed tube" are referred to as "pipe" and "positioning means" by Cullen.

ATTACHMENT TO EXHIBIT A

PATENTED AUG 29 1972

3,687,061

SHEET 4 OF 5

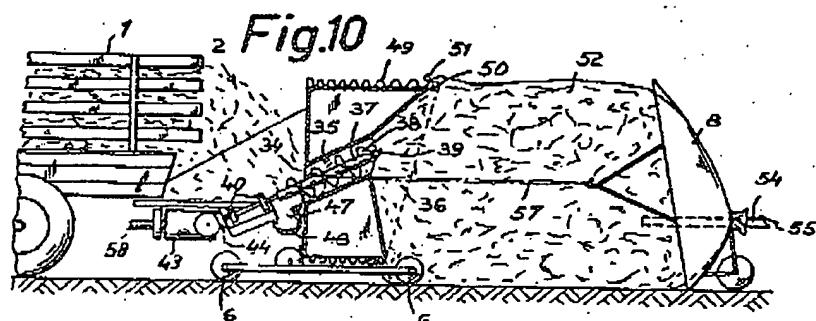
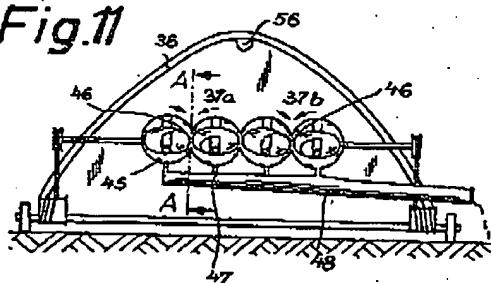


Fig.11



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